

REMARKS

I. Status Summary

Claims 1-77 as filed in the instant U.S. patent application were subject to a Restriction/Election Requirement. In response to the Restriction/Election Requirement, Applicants elected the claims of Group III, Claims 14-29 and newly added claims 78-80, for prosecution at this time, as well as the sequence of SEQ ID NO. 1 as a sequence upon which the U.S. Patent and Trademark Office (hereinafter the "Patent Office") could initiate a search.

Claims 1-13, 30-67, and 75-77 have been withdrawn from consideration. Claims 14-29 and 78-80 are pending and have been examined by the Patent Office.

Applicants request cancellation of Claims 1-80 without prejudice. Applicants hereby reserve the right to file on or more divisional patent application to the subject matter of previously withdrawn and now cancelled claims 1-13, 30-67, and 71-77. Additionally, please add new Claims 81-94.

Claims 14-16, 18-24, 26-29 and 78-80 have been rejected under the provisions of 35 U.S.C. §112, second paragraph.

Claims 14-16, 20-24, 26-29 and 78-80 have been rejected under the provisions of 35 U.S.C. §112, first paragraph.

Claims 14-16, 19-24, 26-29 and 78-80 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,834,240 to Bandman et al.

Claims 14-29 and 78-80 have been canceled in the present amendment.

New Claims 81-94 represent the subject matter of the elected invention, but rewritten to address the rejections of the Patent Office and to facilitate prosecution to allowance of the present application as expeditiously as possible. Support for new Claims 14-29 and 78-80 can be found in the claims and specification as originally filed. Specifically, support for the percent identity set forth in the new claims can be found at pages 18, 22 and 27. New Claims 81-94 do not introduce any new matter.

Reconsideration of the application as amended and based on the arguments set forth herein below is respectfully requested.

II. Oath/Declaration

The Patent Office argues that the Oath or declaration is defective in that the oath or declaration only claims priority to the PCT application and not the provisional application, as set forth in the priority claim of the specification. Applicants respectfully traverse the Patent Office on this issue. Current Patent Office rules only require a claim of priority on the oath or declaration when the claim of priority is made to a foreign application for patent. See 37 C.F.R. § 1.63(c). As this application claims priority to a U.S. provisional application, a claim of priority to it on the oath or declaration is not believed to be required.

III. Specification

The Patent Office requires submission of the abstract on a separate sheet. Applicants have complied with this requirement, submitting the abstract on a separate sheet attached hereto.

IV. Response to Claim Objections

The Patent Office has objected to Claim 19, requiring correction of the claim by the insertion of "is" before "selected." Applicants have deleted Claim 19, thereby rendering this objection moot.

V. Response to Drawings Objections

Replacement drawing sheets for Figures 1-11 are attached. The replacement drawing sheets correct the deficiencies cited by the Patent Office in form PTO-948. Namely, the figures have been amended to comply with margin requirements, line uniformity, shading, and legibility. Furthermore, the replacement drawing sheets are now fully in compliance with 37 CFR 1.84.

VI. Response To 35 U.S.C. §112, Second Paragraph Rejections

Claims 14-16, 18-24, 26-29 and 78-80 are rejected under 35 U.S.C. §112, second paragraph. The Patent Office states that the claims are rejected "as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention."

While the Applicants respectfully neither agree nor acquiesce to the analysis by the Patent Office, Claims 14-16, 18-24, 26-29 and 78-80 have been canceled above in the interest of expediting prosecution of the application. New claims 81-94 encompass the subject matter of the cancelled claims, but are rewritten to more particularly claim the present invention. In view of the foregoing, Applicants respectfully submit that the 35 U.S.C. §112, second paragraph, rejections related to indefiniteness issues have been rendered moot. Accordingly, withdrawal of these rejections are respectfully requested.

VII. Response To Second 35 U.S.C. §112, First Paragraph Rejections

Claims 14-16, 20-24, 26-29 and 78-80 are rejected under 35 U.S.C. §112, first paragraph. The Patent Office states that the claims are rejected for "containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention."

Respectfully, the Applicant neither agrees nor acquiesces to the analysis by the Patent Office. The Applicant respectfully notes that "there is a strong presumption that an adequate written description of the claimed invention is present when the application is filed." Manual of Patent Examining Procedure, Eighth Edition, Revision 1 (February 2003) (hereinafter "MPEP"), §2163 (I)(A) at page 2100-160, citing In re Wertheim, 191 USPQ 90,97 (CCPA 1976). Consequently, "rejection of an original claim for lack of written description should be rare." MPEP, §2163 (II) (A), at page 2100-163 (*emphasis added*). The Applicant maintains that the disclosure of the specification as filed adequately supports the claims as filed, and conveys to one of skill in the art

that the Applicant was in full possession of the claimed invention at the time of the filing of the application.

However, for the purpose of expediting prosecution of the present application, Claims 14-16, 20-24, 26-29 and 78-80 have been canceled. New claims 81-94 encompass the subject matter of the cancelled claims, but are rewritten to more particularly claim the present invention. In view of the foregoing, Applicants respectfully submits that the 35 U.S.C. §112, first paragraph rejections related to written description issues have been rendered moot. Accordingly, withdrawal of this rejection is respectfully requested.

VIII. Response To 35 U.S.C. §102(b) Rejection

Claims 14-16, 19-24, 26-29 and 78-80 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,834,240 to Bandman et al. Applicants respectfully do not agree with or acquiesce to the Patent Office's rejection. However, in the interest of expediting prosecution of the instant case, Claims 14-16, 19-24, 26-29 and 78-80 have been canceled. New claims 81-94 encompass the subject matter of the cancelled claims, but are rewritten to more particularly claim the present invention. Accordingly, Applicants respectfully submit that the rejection under 35 U.S.C. §102(b) has been rendered moot and withdrawal of this rejection is respectfully requested.

New claim 81, recites a polynucleic acid encoding a STRAP polypeptide which is at least about 99% identical to the sequence set forth in SEQ ID NO: 2. Claims 82-94 depend either directly or indirectly from claim 81. Applicants respectfully submit that new claims 81-94 are allowable over Bandman et al.

CONCLUSIONS

In light of the above amendments and remarks, it is respectfully submitted that the present application is now in proper condition for allowance. Early passage of the subject application to issue is earnestly solicited.

Should there be any minor issues outstanding in this matter, Examiner Seharaseyon is respectfully requested to telephone the undersigned attorney.

DEPOSIT ACCOUNT

The Commissioner is hereby authorized to charge any deficiency or credit any overpayment associated with the filing of this correspondence to Deposit Account Number **50-0426**.

Respectfully submitted,

JENKINS, WILSON & TAYLOR, P.A.

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Enclosures